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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,719	03/09/2001	Lewis T. Williams	2300-1624	9010

7590

02/10/2003

Chiron Corporation Intellectual Property -R440
PO Box 8097
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EXAMINER

ZEMAN, MARY K

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,719

Applicant(s)

WILLIAMS ET AL

Examiner

Mary K Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, claims 1-8 in Paper No. 14 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's further election of SEQ ID NO: 222 in Paper No. 14 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant is reminded that the restriction to a single sequence was **not** an election of species requirement, but a further **restriction** between patentably distinct inventions. Applicant is not entitled to the further search and examination of other sequences should the elected sequence be found free of the art. Applicant is encouraged to re-read the restriction requirement at pages 4-5.

Claims 9-15 *and all other sequences* are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 14.

Priority

Priority under 35 USC 119(e) to a provisional application is acknowledged.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Art Unit: 1631

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The origin of the polynucleotide fails to further limit the nature of the polynucleotide itself, therefore, this claim fails to limit the scope of the genus of polynucleotides being claimed.

35 U.S.C. 101/112 Utility Rejections

The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

The examiner is using the following definitions in evaluating the claims for utility:

"Specific" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 1-8 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or a well established utility.

The claimed subject matter is not supported by a specific, substantial, and credible utility because the disclosed uses are generally applicable to broad classes of this subject matter. In addition, further characterization of the claimed subject matter would be required to identify or reasonably confirm a "real world" use. The examiner does not find an adequate nexus between the evidence of record and the asserted properties of the claimed subject matter.

The claims are drawn to isolated polynucleotides having part or all of a sequence selected from the group consisting of SEQ ID NO: 222. At page 5 of Table 1, the following information is set forth about SEQ ID NO: 222: it belongs in cluster 555911; It has a sequence name of RTA22200023F.f.21.P.SEQ; it is in the forward orientation; it has a clone ID of: M00055050:74; and can be found in library CH17COHLV. In Table 2 of the disclosure, SEQ ID NO: 222 is asserted to have some "significant homology" with two known sequences: AC007047, a hypothetical protein from Arabidopsis, and M24566, a tRNA-Glu-GAA gene from slime mold. In table 5 of the specification, SEQ ID NO: 222 is asserted to be present more often in colon metastasis cells than in normal colon cells or colon tumor cells. SEQ ID NO: 222 is not assessed or listed in any of tables 8-14, which purport to link sequences to disease states in actual patients.

All of the above information regarding the potential identity of any sequence encoded by SEQ ID NO: 222 was done by computer analysis, which was not born out by searches done by the examiner. None of the assertedly homologous proteins were found to be relevant hits when SEQ ID NO: 222 was searched using a Smith-Waterman Algorithm, or a BLAST-type algorithm. The elected polynucleotide was not tested for any particular activity in the specification. The only tissue specificity tests appear to have been done in three types of tissues, with no analysis of the presence or absence of SEQ ID NO: 222 in any other tissues. Therefore, it is difficult to interpret these result as being significant.

General uses of polynucleotides set forth in the specification, as filed, include chromosome mapping, to fish out full gene sequences, RFLP analysis, DNA fingerprinting, the expression of any encoded polypeptides, and identification of diseases linked to a sequence (pages 24-43). These general uses are not specific and substantial, as they do not require any one

Art Unit: 1631

particular sequence. Further, they provide no specific information about any one sequence. For example, for the asserted utility of chromosomal mapping no particular chromosome, and chromosomal location has been assigned to any particular nucleotide sequence. Therefore one of ordinary skill in the art would have to perform additional tests to determine which specific chromosomal location is identified by each polynucleotide sequence disclosed, and further determine whether the particular sequence would be practical to use in chromosomal mapping studies..

The need for such further research and experimentation clearly indicates that the asserted utilities for the polynucleotides are not disclosed and therefore are not specific, substantial and credible utilities. Further no well established utility is supported for any one polynucleotide. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. Identifying and studying the properties of the claimed subject matter itself or the mechanisms in which the claimed subject matter is involved does not define a "real world" context or use. Similarly, the other listed and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to a myriad of such compounds. Neither the specification as filed nor any art of record discloses or suggests any property or activity for the claimed polynucleotides such that another non-asserted utility would be well-established for the compounds.

Applicant should explicitly identify a specific, substantial, and credible utility for the claimed invention and establish a probative relation between any evidence of record and the originally disclosed properties of the claimed invention.

Claim(s) 1-8 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

35 USC 112, First Paragraph, Written Description

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses SEQ ID NO: 222 which is asserted to correspond to some unidentified human protein. Claims directed to isolated polynucleotides consisting of SEQ ID NO:222 would meet the written description requirement. However, claims 1-8 are directed to encompass gene sequences, sequences that hybridize to SEQ ID NO: 222, corresponding sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have a recited degree of identity (similarity, homology), and sequences that can be obtained by using some small portion of the disclosed SEQ ID NO: 222. None of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

With the exception of SEQ ID NO: 222, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Art Unit: 1631

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606.

The name cDNA is not itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA. Describing a method of preparing a cDNA or even describing the protein that the cDNA encodes, as the example does, does not necessarily describe the cDNA itself. No sequence information indicating which nucleotides constitute human cDNA appears in the patent, as appears for rat cDNA in Example 5 of the patent. Accordingly, the specification does not provide a written description of the invention of claim 5.

Therefore, only SEQ ID NO: 222 but none of the sequences encompassed by the claims meet the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115.)

Art Unit: 1631

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The deposit of biological organisms is considered by the Examiner to be necessary for enablement of the current invention see 37 CFR 1.808(a). Specifically, it is noted that claim 3 recites deposited material in the body of the claim and that claims 6-8 depend from claims reciting the deposited material. The Examiner acknowledges the deposit of organisms under ATCC accession numbers ES94, Clone number M00055050C:G04 in partial compliance with this requirement. However, the deposits are not in full compliance with 37 CFR 1.803-1.809.

If a deposit is made under terms of the Budapest Treaty, then an affidavit or declaration by Applicants or person(s) associated with the patent owner (assignee) who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty *and* that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements. See 37 CFR 1.808.

If a deposit is not made under the terms of the Budapest Treaty, than an affidavit or declaration by Applicants or person(s) associated with the patent owner (assignee) who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, should be submitted stating that the deposit has been made at an acceptable depository *and that* the following criteria have been met:

- 1) during the pendency of the application, access to the deposit will be afforded to one determined by the Commissioner to be entitled thereto;
- 2) all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent;
- 3) the deposit will be maintained for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposited material;
- 4) a viability statement in accordance with the provisions of 37 CFR 1.807; and
- 5) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

Art Unit: 1631

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Database Record AI459918 (3/1/99).

The claims are drawn to polynucleotides that hybridize to SEQ ID NO: 222, or its complement, fragments thereof, or polynucleotides that could be amplified by a short stretch of SEQ ID NO: 222.

Database Record AI459918 discloses a polynucleotide. The complement of this polynucleotide comprises 49 contiguous nucleotides of SEQ ID NO: 222, and would hybridize to it. This sequence could also be amplified by a portion of SEQ ID NO: 222, and would hybridize to something that is 90% homologous to SEQ ID NO: 222. This sequence was cloned into a vector, and transformed into a host cell. Therefore, this meets the limitations of the rejected claims.

Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Database Record AA743908 (2/19/1998).

The claims are drawn to polynucleotides that hybridize to SEQ ID NO: 222, or its complement, fragments thereof, or polynucleotides that could be amplified by a short stretch of SEQ ID NO: 222.

Database Record AA743908 discloses a polynucleotide. The complement of this polynucleotide comprises 49 contiguous nucleotides of SEQ ID NO: 222, and would hybridize to it. This sequence could also be amplified by a portion of SEQ ID NO: 222, and would hybridize to something that is 90% homologous to SEQ ID NO: 222. This sequence was cloned into a vector, and transformed into a host cell. Therefore, this meets the limitations of the rejected claims.

Art Unit: 1631

Conclusion

No claim is allowed.

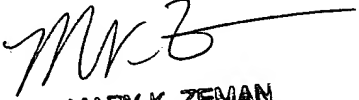
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

Official fax numbers for this Art Unit are: (703) 308-4242, (703) 872-9306. An *unofficial* fax number, direct to the Examiner is (703) 746 5279. Please call prior to use of this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz
2/8/03


MARY K. ZEMAN
PRIMARY EXAMINER
